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APPLICATION NO.	FILING DATE.	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,164	03/05/2004	Scott A. Brown	PO-8687-US / 53699	1041

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EXAMINER	
COONEY, JOHN M	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/801,164	BROWN, SCOTT A.	
	Examiner	Art Unit	
	John m. Cooney	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,13-29,31 and 32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,13-29,31 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's arguments filed 12-14-05 have been fully considered but they are not persuasive.

Rejection under 35 USC 112 is withdrawn in light of applicants' amendments. The following rejections are maintained:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-11, 13-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagquist (6,288,133) in view of McBrien et al.(5,328,648) and Isobe et al.(6,433,033).

Hagquist discloses preparations of polyurethane foam materials used in the filling of gaps wherein polyols, isocyanates, and plasticizers reading on the ester diluents as claimed are employed (see the entire document).

Hagquist differs from the claims in that the gap being filled is not one containing the junction of two pipes that are enclosed by a mold. However, McBrien et al. discloses operations for filling a gap at the junction of two pipes through insertion of gap fill composition into a placed mold enclosing the gap so as to protect exposed surfaces at the junctions of pipes from corrosion (see the entire document). Accordingly, it would

have been obvious for one having ordinary skill in the art to have employed the gap filling technique of McBrien et al. as the gap filling operation practiced within the teachings of Hagquist for the purpose of achieving the desired joint fill effect in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Hagquist further differs from claims of applicants' invention in that plasticizers reading on applicants' diluents are not employed in amounts as particularly recited in applicants' claim 1. However, Hagquist does teach employment of upwards of 25% per reactive part of his plasticizing material for the purpose of improving flow characteristics of the gap filling operation (see again, column 9 lines 21-38). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the plasticizing materials of Hagquist in varied amounts within the operations of Hagquist for the purpose of imparting their flow enhancing effect in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Extension of amounts beyond the recited amounts for further increases in flow characteristics would be within the skill of the ordinary practitioner with an expectation of success and does not rise to the level of a patentable distinction without the showing of new or unexpected results attributable to applicants' ranges of values.

Hagquist further differs from claims of applicants' invention in that amine based polyether polyols are not particularly employed. However, Isobe et al. discloses amine based polyether polyols to be well known polyols useful as acceptable polyether polyols

in polyurethane foam synthesis (see column 10 lines 1-28, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the amine based polyether polyols of Isobe et al. in the preparations of Hagquist for the purpose of imparting its isocyanate reactive effect in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicant's arguments have been considered but rejection is maintained for the reasons set forth in the rejection above.

Although Hagquist's teaching of specific ranges of amount values for its employed plasticizers lacks complete overlap with the scope of applicants' claims for both the A-side and B-side components, the above position is maintained as the reference is clear in its disclosure of the employment of their plasticizers for purposes of flow enhancement of reactants. It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233; *In re Reese* 129 USPQ 402. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272,205 USPQ 215 (CCPA 1980). Additionally, it is noted that applicants' claims do not recite specific ranges of amount values for the respective A-side and B-side components of their claims so that divergence of the ranges of amount values are evident upon mixing of the A- and B-side components. Additionally, it is noted that claims 13-29 and 31-32 do not

contain the limitations discussed in applicants' reply. Accordingly, arguments pertaining to divergence of the ranges of amount values for this additive component are not persuasive of patentability for these claims.

Hagquist is maintained to be properly combined with McBrien et al. for the reasons set forth above. That McBrien et al. concerns itself with discussion of variations in the behaviors of plasticizers does not persuasively rebut examiner's position of prima facie obviousness. McBrien et al. is looked to for its teaching of operations for filling a gap at the junction of two pipes through insertion of gap fill composition into a placed mold enclosing the gap so as to protect exposed surfaces at the junctions of pipes from corrosion so as to cure the deficiencies of Hagquist. McBrien et al. is not depended upon for its disclosure of plasticizers in remedying the deficiencies Hagquist, and it is maintained that its disclosure pertaining to these materials does not negate the appropriateness of its combination with Hagquist.

As to applicants' arguments pertaining to the employment of amine based polyether polyols, rejection is maintained as proper for the reasons set forth above. Hagquist discloses other polyols to be usably employed in the practice of their operations, and Isobe et al. discloses these polyols to be acceptable species useful in the manufacture of polyurethane foams. The references are maintained to be properly combined for the reasons set forth above, and applicants' set forth no showing of unexpected results attributable to the employment of these polyols in order to overcome the position of obviousness set forth. Additionally, though Hagquist may disclose preferred species of polyols in the practice of his invention does not negate what is fully

disclosed by the entirety of his teaching (see again, for example, column 6 lines 27-35). It should additionally be noted that not all of applicants' claims require the employment of amine based polyether polyols.

Double Patenting

Claims 1-11 13-29 and 31-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,521,673 in view of McBrien et al.

The claims U.S. Patent # 6,521,673 discloses compositions, combinational methods, reactants and amount selections which vary from applicants' claims in a manner which would have been obvious to one having ordinary skill in the art. Looking to the specification of 6,521,673 for supporting disclosure provides disclosure of employment of diluents to the degrees claims and employment of amine based polyether polyols for the achievement of desired effects.

The claims of 6,521,673 do differ in that its disclosure supported applications do not recite that gap filling be one containing the junction of two pipes which are enclosed by a mold. However, McBrien et al. discloses operations for filling a gap at the junction of two pipes through insertion of gap fill composition into a placed mold enclosing the gap so as to protect exposed surfaces at the junctions of pipes from corrosion (see the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the gap filling technique of McBrien et al. as the gap filling operation practiced within the disclosure supported applications of 6,521,673 for the

purpose of achieving the desired joint fill effect in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Rejection of applicants' claims for the reasons set forth above is maintained as proper. Applicants' election to address this rejection upon indication of otherwise allowable subject matter is acceptable.

Claims 1-11, 13-29, 31, and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-45, 47, and 48 of copending Application No. 10/326,338 in view of McBrien et al.

The claims of Application # 10/326,338 discloses compositions, combinational methods, reactants and amount selections which vary from applicants' claims in a manner which would have been obvious to one having ordinary skill in the art. Looking to the specification of 10/326,338 for supporting disclosure provides disclosure of employment of diluents to the degrees claims and employment of amine based polyether polyols for the achievement of desired effects.

The claims of 10/326,338 do differ in that its disclosure supported applications do not recite that gap filling be one containing the junction of two pipes which are enclosed by a mold. However, McBrien et al. discloses operations for filling a gap at the junction of two pipes through insertion of gap fill composition into a placed mold enclosing the

gap so as to protect exposed surfaces at the junctions of pipes from corrosion (see the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the gap filling technique of McBrien et al. as the gap filling operation practiced within the disclosure supported applications of 10/326,338 for the purpose of achieving the desired joint fill effect in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

This is a provisional obviousness-type double patenting rejection.

Rejection of applicants' claims for the reasons set forth above is maintained as proper. Applicants' election to address this rejection upon indication of otherwise allowable subject matter is acceptable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700